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EXAMINER

STRANGE, AARON N

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Please find below and/or attached an Office communication concerning this application or proceeding.

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4 UNITED STATES PATENT AND TRADEMARK OFFICE
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7 BEFORE THE BOARD OF PATENT APPEALS
8 AND INTERFERENCES
9

10
11 *Ex parte* DAVID YACH
12

13 Appeal 2008-1454
14 Application 09/728,543¹
15 Technology Center 2100
16

17
18 Decided: May 15, 2008
19

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21
22 Before JOSEPH L. DIXON, LANCE LEONARD BARRY, and
23 CAROLYN D. THOMAS, *Administrative Patent Judges*.
24

25 THOMAS, C., *Administrative Patent Judge*.
26

27 DECISION ON APPEAL
28

29 I. STATEMENT OF THE CASE

30 Appellant appeals under 35 U.S.C. § 134 from a final rejection
31 of claims 44-74 mailed September 7, 2006. We have jurisdiction under
32 35 U.S.C. § 6(b).

¹ Application filed December 1, 2000. The real party in interest is Research In Motion Limited.

1 We affirm.

2

3 A. INVENTION

4 Appellant invented a system and method for enabling the browsing of
5 World Wide Web (WWW) content without the need for a traditional web
6 browser application operating at the client machine. (Spec., 2.)

7

8 B. ILLUSTRATIVE CLAIM

9 The appeal contains claims 44-74. Claims 1-43 are canceled. Claims
10 44, 55, 64, 65, 73, and 74 are independent claims. Claim 44 is illustrative:

11 44. A method of browsing content maintained in a page-
12 rendered language without the use of a page-rendering browser
13 application on a mobile communication device, comprising:
14 generating a request for content at the mobile
15 communication device and transmitting the request to a gateway
16 coupling the mobile communication device to a data network;
17 forwarding the content request from the gateway to a
18 server on the data network where the content is stored in the page-
19 rendered language;
20 returning the requested page-rendered content from the
21 server to the gateway;
22 translating the page-rendered content into a
23 programmatic language and generating a corresponding executable
24 program at the gateway; and
25 forwarding the executable program to the mobile
26 communication device which executes the program in order to browse
27 the requested content.

28

1 C. REFERENCE

2 The single reference relied upon by the Examiner in rejecting the
3 claims on appeal is as follows:

4 Schwartz US 6,473,609 B1 Oct. 29, 2002
5 (Filed Sep. 14, 1998)
6

7 D. REJECTION

8 The following rejection is before us for review²:
9 Claims 44-46, 48-52, 55-61, 64-70, 73, and 74 are rejected under
10 35 U.S.C. § 102(e) as being anticipated by Schwartz.

11
12 II. PROSECUTION HISTORY

13 Appellant appealed from the Final Rejection and filed a second
14 Appeal Brief (App. Br.) on February 27, 2007. The Examiner mailed an
15 Examiner's Answer (Ans.) on June 12, 2007. Appellant filed a Reply Brief
16 (Reply Br.) on August 9, 2007. The request for an Oral Hearing was timely
17 waived on March 19, 2008.
18

² In the Examiner's Answer on page 3, the following rejections were withdrawn: The rejection of claims 44-52, 55-61, 64-70, 73, and 74 under 35 U.S.C. § 102(e) as being anticipated by Lowery (US 6,446,111), or in the alternative, under 35 U.S.C. § 103(a) as obvious over Lowery in view of Schwartz (US 6,473,609). In addition, see page 3 of the Answer for the grounds of rejection that have not been withdrawn by the Examiner, but are not under review by the Board because they were not argued in Appellant's Appeal Brief.

III. ISSUE

Whether Appellant has shown that the Examiner erred in rejecting claims 44-46, 48-52, 55-61, 64-70, 73 and 74 as being anticipated by Schwartz.

IV. FINDINGS OF FACT

The following findings of fact (FF) are supported by a preponderance of the evidence.

Claim Construction

1. The Specification does not provide a lexicographic definition for the terms “interpreter”, “executing”, and “rendering”.

2. The ordinary and usual meaning of “interpreter” is a computer program that translates an instruction into machine language and executes it before going to the next instruction. *Webster’s Ninth New Collegiate Dictionary* p. 633 (1985)

3. The ordinary and usual meaning of “executing” is to perform indicated tasks according to encoded instructions. *Merriam-Webster’s Collegiate Dictionary* 436 (11th ed. 2005).

4. The ordinary and usual meaning of “rendering” is to direct the execution of. *Webster’s Ninth New Collegiate Dictionary* p. 997 (1985)

Schwartz

5. Schwartz discloses that “a mobile device cannot efficiently operate the browser used by desktop computers to navigate the Internet. . . . There is, therefore, a great need for a solution that enables mobile devices to freely

1 access information on the Internet without providing these computing
2 resources in the mobile devices.” (Col. 2, ll. 8-15.)

3 6. Schwartz discloses that “in prior art systems, terminal devices
4 typically run a local browser such as the one from Netscape™ or
5 Microsoft™ to interact with the Internet. The present invention, however,
6 uses an interface engine in a terminal device and a control engine in a proxy
7 server.” (Col. 10, ll. 54-58.)

8 7. Schwartz discloses “if working directly with the HDML files, the
9 terminal (i.e., the mobile device) would require both considerable memory to
10 cache the HDML files, history and activity states and sufficient computing
11 power to run a browser to work with the cached HDML files. One aspect
12 which differentiates the present invention fundamentally from prior art
13 systems is that the control engine in the link server is responsible for tasks
14 that require computing resources while the interface engine in the terminal is
15 only responsible for rendering the screen description data to cause the
16 display screen to display contents and receive inputs from a user.” (Col. 12,
17 ll. 43-54.)

18 8. Schwartz discloses that “the actual data being exchanged between
19 link server **300** and mobile device **350** is in SDD format, which is typically
20 binary” (Col. 10, ll. 3-6.)

21 9. Schwartz discloses that “[a]ccording to another embodiment, the
22 message processor does not have a pair of separate message digester and
23 converter, a markup language file in HDML, compact HTML or XML is
24 received at the message processor and converted into a corresponding binary
25 file that is much smaller in size and may be in Imp, cHDML, cHTML, or

1 cXML, wherein ‘c’ means stripped, compressed, compiled or converted
2 version of the corresponding markup files.” (Col. 10, ll. 11-18.)
3

4 V. PRINCIPLES OF LAW

5 “A claim is anticipated only if each and every element as set forth in
6 the claim is found, either expressly or inherently described, in a single prior
7 art reference.” *Verdegaal Bros., Inc. v. Union Oil Co. of California*,
8 814 F.2d 628, 631 (Fed. Cir. 1987). Analysis of whether a claim is
9 patentable over the prior art under 35 U.S.C. § 102 begins with a
10 determination of the scope of the claim. We determine the scope of the
11 claims in patent applications not solely on the basis of the claim language,
12 but upon giving claims their broadest reasonable construction in light of the
13 specification as it would be interpreted by one of ordinary skill in the art.
14 *In re Am. Acad. of Sci. Tech. Ctr.*, 367 F.3d 1359, 1364 (Fed. Cir. 2004).
15 The properly interpreted claim must then be compared with the prior art.
16

17 VI. ANALYSIS

18 *Grouping of Claims*

19 In the Brief, Appellant argues claims 44-46, 48-52, 55-61, 64-70, 73,
20 and 74 as a group (App. Br. 9-11). In other words, for claims 44-46, 48-52,
21 55-61, 64-70, 73, and 74, Appellant merely repeat the same arguments.
22 Thus, the Board selects representative claim 44 to decide the appeal for this
23 group. 37 C.F.R. § 41.37(c)(1)(vii)(2006). Accordingly, the remaining
24 claims in this group stand or fall with claim 44. *See* 37 C.F.R.
25 § 41.37(c)(1)(vii). *See also In re Young*, 927 F.2d 588, 590 (Fed. Cir. 1991).
26

The Board's Claim Construction

"Our analysis begins with construing the claim limitations at issue."
Ex Parte Filatov, No. 2006-1160, 2007 WL 1317144, at *2 (BPAI 2007).
Claims are given their broadest reasonable construction "in light of the
specification as it would be interpreted by one of ordinary skill in the art."
In re Am. Acad. of Sci. Tech. Ctr., 367 F.3d 1359, 1364 (Fed. Cir. 2004).

To determine whether Schwarz anticipates illustrative claim 44, we
must first determine the scope of the claim. Our reviewing court stated in
Phillips v. AWH Corp., 415 F.3d 1303, 1315 (Fed. Cir. 2005), *cert. denied*,
sub nom. AWH Corp. v Phillips, 126 S. Ct. 1332 (2006): The claims, of
course, do not stand alone. Rather, they are part of "a fully integrated
written instrument," *Markman*, 52 F.3d at 978, consisting principally of a
specification that concludes with the claims. For that reason, claims "must
be read in view of the specification, of which they are a part." *Id.* at 979. As
we stated in *Vitronics*, the specification "is always highly relevant to the
claim construction analysis. Usually, it is dispositive; it is the single best
guide to the meaning of a disputed term." 90 F.3d at 1582.

We note that Appellant has not identified any specific definition for
the terms "interpreter", "executing" and "rendering" (FF 1), nor are we
aware of any special definition in the art for these terms. From our review
of the original Specification, we find no express definition of these terms in
the Specification. Therefore, we give the above-mentioned terms their
ordinary and customary definition (FF 2-4).

The Anticipation Rejection

We now consider the Examiner's rejection of illustrative claim 44 under 35 U.S.C. § 102(e) as being anticipated by Schwartz.

"Having construed the claim limitations at issue, we now compare the claims to the prior art to determine if the prior art anticipates those claims." *In re Cruciferous Sprout Litig.*, 301 F.3d 1343, 1349 (Fed. Cir. 2002).

Initially, we note that although Appellant argues that the "independent claims of this application *all* (emphasis added) require that the page-rendered code is translated into programmatic code that can be executed at the mobile device, without the use of a page-rendering application," (App. Br. 11) Appellant has chosen not to draft *all* the independent claims as argued. For example, only independent claims 44 and 73 recite the "*without the use of a page-rendering browser application*", and independent claim 64 merely recites "*without the use of a web browser application*." Independent claims 55, 65, and 74 do not recite "*without the use of a page-rendering browser application*" nor any other similar language. Therefore, the above-noted argument has been considered, but applies only to claims containing the specific limitation.

Furthermore, we note that while independent claims 44, 64, and 73 recite language related to the "*without*" clause presented *supra*, the actual language used in the claims also include a "browser application".

Now that we have clarified what is actually being claimed, we next compare the claims to the prior art.

Regarding claims 44, 64, and 73, Appellant contends that "in order for Schwartz to anticipate theses claims, the reference must disclose or suggest the browsing of page-rendered content without an application that renders

1 the content. This is not possible, however, because the Schwartz reference
2 repeatedly and consistently indicates that his invention requires a page-
3 rendering application.” (Reply Br. 4.) We disagree.

4 Schwartz discloses that there is a need to enable a mobile device to
5 access information on the Internet without providing a browser in the mobile
6 device (FF 5). Schwartz also discloses that while prior art mobile devices
7 run a local browser to interact with the Internet, its mobile device uses an
8 interface engine (FF 6). Furthermore, Schwartz discloses that the interface
9 engine in the mobile device is only responsible for rendering the screen
10 description data, instead of browsing HDML files (FF 7).

11 In other words, Schwartz discloses avoiding the use of a “browser”
12 component in its mobile device. Instead, Schwartz uses an interface engine
13 that renders the data so as to cause the display screen to display content.
14 Thus, we find that Schwartz reads on the “without the use of a page-
15 rendering *browser* application” limitation found in claims 44, 64, and 73.

16 Regarding the *rendering* feature of Schwartz, Appellant contends:

17 The Examiner’s Answer essentially equates these operations
18 [“rendering” and “executing”], finding that Schwartz’s page-rendering
19 interface engine, which operates on a data file, is the same as the
20 claimed functionality of executing or interpreting an executable
21 program that has been translated from a page-rendered data file into a
22 programmatic language. These operations, however, are not the same,
23 and therefore the anticipation rejection over Schwartz should be
24 reversed.

25
26 (Reply Br. 6.)

27 In other words, Appellant essentially contends that Schwartz’s
28 “rendering” is distinguishable from the claimed “executing”. We disagree

1 We find that “rendering” as disclosed by Schwartz is merely directed
2 to the *execution* of the Screen Description Data (SDD) (FF 4), instead of
3 using a page-rendering browser application as negatively recited in the
4 claims. Schwartz clearly discloses avoiding the use of a browser application
5 in its mobile device. Thus, we find that Schwartz’s mobile device
6 “rendering the screen description data” reads on the claimed “mobile
7 communication device which executes the program.”

8 Regarding whether Schwartz’s SDD format is a program as claimed,
9 Appellant contends the following regarding Schwartz:

10 As these quotations from Schwartz demonstrate, the reference clearly
11 does not disclose or suggest the possibility of converting page-
12 rendered code into programmatic code that can be directly executed
13 by the client device. Rather, in Schwartz, the page-rendered code is
14 merely converted into a more compact form of smaller or less page-
15 rendering code segments. The SDD data that is generated by the link
16 server in the Schwartz reference is still page-rendered code, it is not
17 programmatic code.

18
19 (App. Br. 9-10: see also Reply Br. 6.)

20 The Examiner found that the “actual SDD file is transmitted in ‘SDD
21 format’, which is typically binary (Col. 10, ll. 3-6). Binary files are known
22 in the art, and they contain data specifically intended to be read by a
23 computer.” (Ans. 9.)

24 The Examiner further found:

25 It is clear that a *binary* file containing commands that cause the
26 mobile device to display certain items is an ‘executable program’,
27 well within the broadest reasonable interpretation of that term. . .
28 even if the SDD file could not reasonable [sic] be interpreted as an
29 executable program, which it can, Schwartz also discloses that the
30 message processor can convert the received page rendered content

1 into various *compiled* formats (at least Col. 10, Lines 10-17). It is
2 well known in the art that a computer can execute compiled code.

3 (Ans. 10.)

4 We agree with the Examiner and further do not find that the language
5 of independent claim 44 requires the code to be “directly executed” as
6 argued.

Schwartz discloses that the SDD format transmitted to the mobile device is typically in binary form and even may be a compiled version of the corresponding markup files (FF 8-9). Thus, we find that Schwartz’s disclosed compiled binary version of the SDD format reads on the claimed “programmable language”.

Therefore, we do not find that Appellant has shown error in the Examiner's rejection of illustrative claim 44. Instead, we find the Examiner has set forth a sufficient initial showing of anticipation, and Appellant has not shown that Schwartz lacks the above-noted disputed features of claim 44. Therefore, we affirm the rejection of independent claim 44 and of claims 45, 46, 48-52, 55-61, 64-70, 73, and 74, which fall therewith.

As for the non-argued separate rejections under Section 103(a) for claims 47, 53, 54, 62, 63, 71, and 72 (see footnote 2), we note that arguments which Appellant could have made but chose not to make in the Briefs have not been considered and are deemed to be waived. Thus, we also pro forma affirm the separate rejections under 103(a) of claims 47, 53, 54, 62, 63, 71, and 72 (see Final Office Action).

24

25 VII. CONCLUSIONS

26 We conclude that Appellant has not shown that the Examiner erred in
27 rejecting claims 44-74.

1 Thus, claims 44-74 are not patentable.

2

3

VIII. DECISION

4 In view of the foregoing discussion, we affirm the Examiner's
5 rejections of claims 44-74.

6 No time period for taking any subsequent action in connection with
7 this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv) (2006).

8

9

10 AFFIRMED

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